

## **REMARKS**

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-22 are pending and stand rejected.

Claims 1-10 are rejected under 35 USC §101 as being non-statutory subject matter as they allegedly describe an abstract idea that is not technologically embodied as being performed on a computer (MPEP 2106 IV.B1(b)). It is the examiner's position that the claims read on the mental steps of calculating a score that can be performed with pencil and paper or in one's head.

Applicant respectfully disagrees with, and explicitly traverses the examiner's reason for rejecting the claims. The law is clear in that "[w]hoever invents or discovers any new and useful process, machine, manufacture ... or any new and useful improvement thereof, may obtain a patent therefore." 35 USC §101. Claim 1 recites a method for recommending items comprising the steps of obtaining a list, obtaining a recommendation score, calculating an adjustment to the recommendation score based on a consistency with which an item was selected and generating a combined recommendation score. Claim 1 recites a new and useful process for calculating an adjustment to a recommended score and generating a combined recommendation score. Contrary to the position taken in the Office Action, 35 USC §101 does not require that the process must be performed on a computer system. Rather 35 USC §101 merely requires a new and useful improvement.

Hence, whether the process recited in claim 1 is performed by a computer system or by hand calculation, the recommendation of an item by a recommendation score and an adjustment thereof to produce a new recommendation score produces a useful result. Hence, practicing the steps recited in claim 1 whether by computer system or by hand calculation is within the scope of the claims and such process is deserving of a patent.

The Office Action refers to MPEP 2106 IV.B1(b) (Nonfunctional Descriptive Material) as the basis of the rejection. However, applicant notes that MPEP 2106

IV.B1(b) describes "nonfunctional descriptive material" as including but not limited to music, literary works and a compilation or mere arrangement of data. The process steps described in claim 1 are neither music, literary works or a mere arrangement of data, but steps that lead to a useful and tangible result.

Applicant further notes that the MPEP 2106 II (A) states that to identify and understand any practical application asserted for the invention, "[t]he claimed invention as a whole must accomplish a practical application. That is it must produce a 'useful, concrete and tangible result'" quoting State Street 149 f.3d at 1371. As an example of patentable subject matter, MPEP 2106 II (A) further recites the findings of the Court in the matter of *AT&T Corp v. Excel Communications, Inc.*, wherein "[c]laims drawn to a long-distance telephone billing process containing mathematical algorithms were held to be directed to patentable subject matter because 'the claimed process applies the Boolean principle to produce a useful, concrete tangible result without pre-empting other uses of the mathematical principle.'" MPEP 2106 II (A).

In this case, the process claimed provides a useful, concrete and tangible result and hence is patentable subject matter.

Having shown that claim 1 includes subject matter that produces a useful result, applicant submits that the reason for the rejection has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

With regard to independent claim 8, this claim recites subject matter similar to that recited in claim 1 and has been rejected citing the same reference used in rejecting claim 1. Accordingly, the applicant's remarks made in response to the rejection of claim 1 are also applicable in response to the rejection of claim 8. Accordingly, in view of the remarks made with regard to the rejection of claim 1, which are reasserted, as if in full, in response to the rejection of claim 8, applicant submits that the rejection of claim 8 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

With regard to claims 2-7 and 9-10, these claims depend from claims 1 and 8, respectively, which have been shown to be allowable. Accordingly, claims 2-7 and 9-10 are also allowable by virtue of their dependency upon an allowable base claim.

Claims 1-22 are rejected under 35 USC§102(b) as being anticipated by Herz (USP No. 5,758,257) in view of Rauch (USP no. 5,758,257).

Applicant respectfully disagrees with, and explicitly traverses, the reason for rejecting the claims.

A claim is anticipated only if each and every element recited therein is expressly or inherently described in a single prior art reference.

Herz cannot be said to anticipate the present invention, because, as is noted in the Office Action (see page 4, lines 13-15), Herz fails to disclose each and every element recited. Thus, the combination of Herz and Raunch cannot be said to anticipate the present invention as neither Herz nor Raunch, individually, describe each and every element claimed and the combination of the references is not an appropriate reason for rejecting the claims.

Having shown that the subject matter recited in claim 1 is not anticipated by either of the cited references, applicant submits that the reason for the rejection has been overcome and requests that the rejection be withdrawn.

With regard to independent claims 8, 11, 18, 21 and 22, these claims have been rejected by the citing the same reference used in rejecting claim 1. Accordingly, the applicant's remarks made in response to the rejection of claim 1 are also applicable in response to the rejection of claims 8, 11, 18, 21 and 22.

In view of the remarks made with regard to the rejection of claim 1, which are reasserted, as if in full, in response to the rejection of claims 8, 11, 18, 21 and 22, applicant submits that the rejection of these claims has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

The other claims in this application are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention,

individual consideration of the patentability of each on its own merits is respectfully requested.

Although the last Office Action was made final, this amendment should be entered. No matter has been added to the claims that would require comparison with the prior art or any further review only require a cursory review is required by the examiner. The amendment therefore should be entered without requiring a showing under 37 CFR 1.116(b).

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,  
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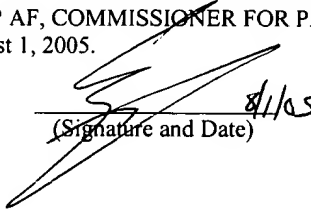
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